

REMARKS

This Amendment is in response to the Office Action dated September 7, 2004 (the "Action"). Applicants affirm the election of Claims 1-11. Claim 12 has been canceled as directed to a non-elected invention.

The Double Patenting Rejection is Improper

Claims 1-11 stand rejected in the Action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 8-17 of U.S. Patent No. 6,729,664. Applicants respectfully submit that this double patenting rejection is improper and request that the rejection be withdrawn.

As noted in the Remarks Accompanying Filing of Divisional Application filed April 7, 2004 with the current application, Claims 1-11 are identical to Claims 1-11 from the U.S. Serial No. 10/278,034 (now issued U.S. Patent No. 6,729,664)(the "parent application"). Claim 1-11 are directed to non-elected inventions identified in the Restriction Requirement of the parent application, which is contained in an Office Action mailed July 30, 2003 (the "Restriction Requirement").

The Restriction Requirement stated that Claims 1-11 were "unrelated" and "distinct" from Claims 12-53 of the parent application. Claims 12-53 correspond to issued Claims 1-42 of U.S. Patent No. 6,729,664. The current Action states that Claims 1-11 of the current application and Claims 1 and 8-17 of U.S. Patent No. 6,729,664 are "not patentably distinct." This double patenting rejection is specifically prohibited by 35 U.S.C. § 121.

The third sentence of 35 U.S.C. § 121 states as follows:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

The prohibition of double patenting rejections Under 35 U.S.C. § 121 is discussed in § 804.01 of the M.P.E.P. Several situations where the prohibition of double patenting under

§ 121 does not apply are also discussed in M.P.E.P. § 804.01, and Applicants submit that none of the exceptions apply to the current application.

Applicants request that the double patenting rejection be withdrawn; however, if the rejection is maintained, Applicants request that the relevant exception to the prohibition of double patenting under § 121 be specifically identified in any subsequent official action.

Prior Art Rejections under 35 U.S.C. § 103

Claim 1, as amended with emphasis added, recites as follows:

A device for protecting first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component.

The Action states that Hightower discloses a base member having opposite first and second faces. The Action concedes that Hightower fails to disclose that the base member has a cushioning projection covering a void within the base member. The Action then characterizes Jones as teaching a device for fastening a door and jamb "wherein the base member (27) includes a cushioning projection (31) covering a void within the base member." The Action further states that the device in Jones is formed of a unitary member.

Applicants respectfully disagree with the Action's characterization of Jones. Jones discloses a solid cushioning projection 31 that is provided as a separate piece from the base 27. As shown in **Figure 5**, Jones proposes a peg-shaped cushioning projection 31 that fits into a hole provided in the base of the fastener so that a dome-shaped projection protrudes away from the base. In the configuration shown in **Figure 5** of Jones, the cushioning projections 31 are solid structures and a void is not shown. Any resiliency of the cushioning projections in Jones is due to the resiliency of the material used to form the cushioning projections 31. See Jones, col. 2, lines 30-33.

In contrast, Claim 1, as amended, recites that the cushioning projection extends outwardly from the second face of the base member, "covering and defining a void within the base member." Jones does not teach or suggest a cushioning projection that covers a void within the base member as recited in the independent claims. However, in order to expedite prosecution, Claim 1 has been amended to recite that the cushioning projection covers and defines a void within the base member. As illustrated by the phantom lines in **Figure 1** of the current application, in some embodiments, the void **122** facilitates compression of the projection **114**. In contrast, any compressibility of the cushioning projections **31** of Jones appear to be due solely to the resiliency of the material used to form the cushioning projections **31**.

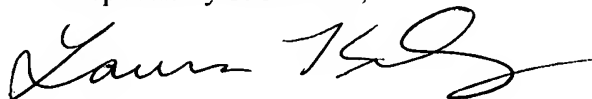
Accordingly, neither Jones nor Hightower teaches or suggests all of the claimed limitations. In addition, there is no motivation in either reference to modify the references to arrive at the claimed invention.

Moreover, at least Claim 2 is independently patentable. Claim 2 recites that the device is formed as a unitary member. As recited in Claim 2, the cushioning projection is provided as part of the device. The Action states that the device in Jones is formed as a unitary member. However, **Figure 5** in Jones clearly shows that the cushioning projections **31** are separate pieces that fit into the base member **27**, and therefore are not formed as a unitary member with the device.

For the reasons discussed above, Applicants request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

In light of the above amendments and remarks, Applicant submits that the pending claims are in condition for allowance. Accordingly, Applicants respectfully request allowance of the present application and passing the application to issue.

Respectfully submitted,



Laura M. Kelley
Registration No. 48,441
Attorney for Applicants



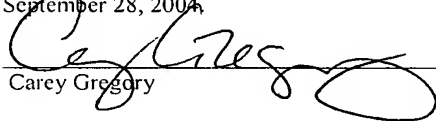
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Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on September 28, 2004.


Carey Gregory